

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

SAINI *ET AL.*

Serial No.: **10/736,339**

Filed: **DECEMBER 15, 2003**

Title: **"ON-THE FLY COATING OF ACID-
RELEASING DEGRADABLE MATERIAL
ONTO A PARTICULATE"**

§ Group Art Unit: **1792**

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§ Confirmation No.: **3700**

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§ Examiner: **LIGHTFOOT, ELENA TSOY**

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§ Atty. Docket No: **2001-IP-005484U1P1**

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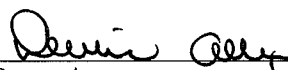
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**CERTIFICATE OF FILING ELECTRONICALLY VIA EFS
37 C.F.R. § 1.8**

I HEREBY CERTIFY THAT I HAVE A REASONABLE BASIS FOR BELIEF
THAT THIS CORRESPONDENCE IS BEING SUBMITTED TO THE UNITED
STATES PATENT AND TRADEMARK OFFICE VIA EFS
(ELECTRONICALLY) ON THE DATE INDICATED BELOW, AND IS
ADDRESSED TO:

MAIL STOP APPEAL BRIEF – PATENTS
HONORABLE COMMISSIONER FOR PATENTS
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450



DEBBIE ALLEN

DATE OF SUBMISSION:
ELECTRONIC FILING (EFS): **DECEMBER 21, 2009**

**MAIL STOP APPEAL BRIEF – PATENTS
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450**

RESPONSE TO NOTIFICATION OF NON-COMPLIANT APPEAL BRIEF

In response to the Notification of Non-Compliant Appeal Brief mailed on
November 20, 2009 (hereinafter the "Notice of Non-Compliant Appeal Brief"), Applicants
submit the following:

- **Amendments to the Status of the Claims**, which begin on page 2; and
- **Remarks**, which begin on page 3.

AMENDMENTS TO THE STATUS OF CLAIMS

Please replace the Status of the Claims section of the Appeal Brief filed on November 5, 2009 with the following Status of the Claims section:

III. STATUS OF THE CLAIMS

The application as originally filed contained claims 1-41. Claims 1-41 have been canceled. Claims 42-61 are pending. Claims 42-61 are finally rejected and appealed. A listing of all appealed claims is provided in Appendix A to this Appeal Brief.

The Examiner has rejected claims 42-48 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,209,643 issued to Nguyen *et al.* (hereinafter “*Nguyen*”) in view of U.S. Patent No. 6,458,867 issued to Wang *et al.* (hereinafter “*Wang*”) in further view of U.S. Patent No. 6,817,414 issued to Lee *et al.* (hereinafter “*Lee*”).¹

The Examiner also has rejected claims 42-48 under 35 U.S.C. § 103(a) as being unpatentable over *Nguyen* in view of *Wang*, and U.S. Patent No. 5,192,615 issued to McDougall *et al.* (hereinafter “*McDougall*”), or over *Nguyen* in view of *Wang* in further view of *Lee* in further view of *McDougall*.²

The Examiner also has rejected claims 55-61 under 35 U.S.C. § 103(a) as being unpatentable over *Nguyen* in view of *Wang* and *McDougall*, or over *Nguyen* in view of *Wang* in further view of *Lee* in further view of *McDougall*.

The Examiner also has rejected claims 49-54 under 35 U.S.C. § 103(a) as being unpatentable over *Nguyen* in view of *Wang*, *Lee*, and U.S. Patent No. 6,669,771 to Tokiwa *et al.* (hereinafter “*Tokiwa*”).

Finally, the Examiner has also provisionally rejected claims 42-54 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-7, 9-11, and 13-17 of co-pending U.S. Application Serial No. 11/046,043 in view of U.S. Patent No. 4,829,100.

Appellants herein appeal the above rejections of claims 42-61 under 35 U.S.C. § 103(a) as improper.

¹ Copies of *Nguyen*, *Wang*, and *Lee* are provided in Appendix E to this Brief.

² A copy of *McDougall* is provided in Appendix E to this Brief.

REMARKS

I. Remarks Regarding Status of the Claims

With respect to the Appeal Brief filed on November 5, 2009, the Notice of Non-Compliant Appeal Brief states:

The brief does not contain a statement of the status of all claims, (e.g., rejected, allowed, withdrawn, objected to, canceled), or does not identify the appealed claims (37 CFR 41.37(c)(1)(iii)).

The brief does not contain a statement of the status of all claims (cancelled). An entire brief is not required just the defective section may be submitted.

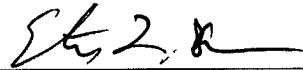
(Notice of Non-Compliant Appeal Brief at 2.) In this response Applicants have submitted an amended Status of the Claims section noting that claims 1-41 have been canceled. Therefore, Applicants respectfully submit that with this amended section, the Appeal Brief is in compliance with 37 C.F.R. 41.37(c).

SUMMARY

In light of the above remarks, Applicants respectfully submit that the Appeal Brief is in compliance with 37 C.F.R. § 41.37. Applicants respectfully request that the final rejections of the pending claims be reversed and the application be remanded for allowance of the pending claims, or, alternatively, remand the application for further examination if appropriate references can be found by the Examiner.

Applicants believe that no fees are due in association with the filing of this response. Applicants note that the Notice of Non-Compliant Appeal Brief was mailed on November 20, 2009. Because the one-month reply date for this response fell on a Sunday, and because Applicants have filed this response on the next possible business day, Applicants believe that this response has been filed timely. Should the Commissioner deem that any fees are due, including any fees for extensions of time, the Commissioner is authorized to debit Baker Botts L.L.P.'s Deposit Account No. 02-0383, Order Number 063718.1357.

Respectfully submitted,



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